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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,897

03/19/2004

Qing Ma

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8201

7590

10/05/2006

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EXAMINER

TUGBANG, ANTHONY D

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/804,897

Applicant(s)

MA ET AL.

Examiner

A. Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29-45 is/are pending in the application.
- 4a) Of the above claim(s) 43-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-33, 40-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/10/06, 7/21/06, 3/23/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. As a result of new Claims 40-45 being added in the response filed on July 10, 2006, the groupings are now as follows.

Species A, Claims 29-33, 41 and 42; and

Species B, Claims 34-39 and 43-45.

Claim 40 is generic to both Species A and B.

2. Applicant's election with traverse of Species A, Claims 29-33, 41 and 42 in the reply filed on July 10, 2006 is acknowledged. The traversal is on the ground(s) that the restriction should be withdrawn because Claim 1 is generic to both Species A and B. This is not found persuasive because while it is true that Claim 40 is a generic claim, Claim 40 is not found to be allowable for the reasons set forth below. Thus, the restriction will be maintained and rejoinder of all the claims will be fully considered if and when, the generic claim is found to be allowable.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 43 through 45 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 10, 2006.

### ***Claim Objections***

4. Claim 29 is objected to because of the following informalities: "an oscillator" (line 2) should be replaced with --the oscillator--. Appropriate correction is required.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 29, 40 and 41 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 29 of copending Application No. 09/738,118 in view of Shimatsu 4,080,696.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all of the steps of Claim 29 of the copending application are found in Claims 29, 40 and 41 of the instant application. The difference between Claims 29, 40 and 41 of the instant application and Claim 29 of the copending application is that the claims of the instant application contain more specific features of determining a first resonant frequency of the oscillator member and adjusting the resonant frequency by removing at least one of the spaced-apart stacks on the vibration portion.

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However, Shimatsu teaches determining a first resonant frequency of the oscillator member and adjusting the resonant frequency by removing at least one of the spaced-apart stacks on the vibration portion (see sequence of Fig.6 and col. 2, lines 56-61) for the benefits of providing an oscillator that is low in power consumption and smaller in size (col. 4, lines 5-9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the claims of copending application (e.g. 09/738,118) by adding the features of determining a first resonant frequency of the oscillator member and adjusting the resonant frequency by removing at least one of the spaced-apart stacks on the vibration portion, as taught by Shimatsu, for the advantages of providing an oscillator that is low in power consumption and smaller in size.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 29 through 33 and 40 through 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimatsu 4,080,696.

Shimatsu discloses a method of tuning an oscillator comprising: providing the oscillator (in Fig. 2) that includes one pedestal (e.g. 7) on a substrate (e.g. casing, not shown); a vibrating

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portion (e.g. 2) of the oscillator supported by the pedestal such that the vibrating portion does not contact the substrate (e.g. casing); a plurality of spaced-apart stacks, or structures (e.g. 3, 4), on one side of the vibrating portion; determining a first resonant frequency of the oscillator member; and adjusting the resonant frequency by removing at least one of the spaced-apart stacks, or structures, on the vibration portion (col. 2, lines 56-64, Fig. 6).

Regarding Claim(s) 30 through 33, 41 and 43, Shimatsu removes the structure, or spaced-apart stack, by directing radiant energy of a laser beam and the vibrating portion is a cantilever beam or bridge beam.

### *Response to Arguments*

9. The applicant(s) arguments with respect to Claims 29 through 33 and 40 through 42 as filed on March 15, 2006 have been considered, but are moot in view of the new ground(s) of rejection set forth above.

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

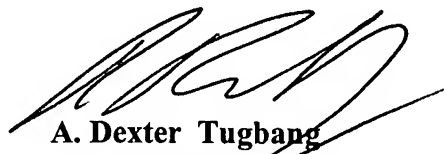
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 571-272-4570. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**A. Dexter Tugbang**  
**Primary Examiner**  
**Art Unit 3729**

September 27, 2006